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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,423

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10/23/2008

EXAMINER

YOUNG, SHAWQUA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

10/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,423	Applicant(s) DELGADO ET AL.	
	Examiner SHAWQUIA YOUNG	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/14/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 3 and 4 are currently pending in the instant application. Applicants have cancelled claims 2, 5 and 6 in an amendment filed on July 14, 2008.

I. *Response to Arguments*

Applicant's amendment, filed July 14, 2008 has partially overcome the rejection of claims 1-4 under 35 USC 112, first paragraph for scope of enablement. Applicants have amended claim 1 to read on a process for making a 1-(hydroxyalkyl)indazole but have not amended the claims to read on the 1-(hydroxyalkyl)indazole compounds as defined in claim 3 which Applicants are enabled for. To overcome the rejection, Applicants need to amend claim 1 to include the formula in claim 3 and the definitions of the variables as in claim 3. Therefore, the rejection has been maintained.

II. *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on July 14, 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

III. *Rejection(s)*

Claim Rejections - 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of making a (hydroxyalkyl)indazole as defined in claim 3 does not reasonably provide enablement for making any 1-(hydroxyalkyl)indazole. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

As stated in the MPEP 2164.01 (a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

In In re Wands, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have need described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

In the instant case

The nature of the invention

The nature of the invention is a method of making a (hydroxyalkyl)indazole of the formula in claim 3 and as defined in claim 3.

The amount of direction or guidance present and the presence or absence of working examples

The specification provides minimal working examples of how to prepare the claimed invention. Applicants have only disclosed one example of how to prepare the claimed invention on pages 9-10. The example is for preparing a (hydroxyalkyl)indazole compound based on the formula in claim 3. It does not provide direction for the preparation of all 1-(hydroxyalkyl)indazoles. Since the chemical moieties encompassed by these terms are variable in reactivity, it cannot be said with absolute certainty such compound can be prepared through the same route as compounds of formula as represented in claim 3.

The breadth of the claims

The breadth of the claims is broader than the disclosure, specifically, the instant claims includes a method of preparing any 1-(hydroxyalkyl)indazole. Thus, multiple derivatives of 1-(hydroxyalkyl)indazole having various functional groups and chemical reactivity are encompassed by the instant claims. However, the specification only provides evidence for compounds of the formula represented in claim 3 and does not provide examples of other types of 1-(hydroxyalkyl)indazole compounds not embraced by the formula in claim 3.

The quantity of experimentation needed and the level of the skill in the art

While the level of the skill in the pharmaceutical art is high, the quantity of experimentation needed is undue experimentation. One of skill in the art would need to prepare compounds with both similar and different structural radicals without any direction as to what structural radical is needed.

The level of skill in the art is high without showing or guidance as to how to make all 1-(hydroxyalkyl)indazole compound other than 1-(hydroxyalkyl)indazole with the formula as defined in claim 1 and it would require undue experimentation to figure out the starting materials, solvents, temperatures and reaction times that would provide any 1-alkylindazole compound

In consideration of each of the above factors, it is apparent that undue experimentation because of variability in prediction of outcome that is not addressed by the present application disclosure, examples, teaching and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue.

To overcome this objection, Applicant should submit an amendment narrowing the scope of the claimed invention to a method of making a 1-(hydroxyalkyl)indazole based on the formula in claim 3.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being

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indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the phrase “has the formula” renders the products in the method claim indefinite as the phrase “has the formula” can be considered open-ended language when not clearly defined and therefore is including additional subject matter in the compounds of the formula represented in claim 3 that is not described in the instant specification and is not particularly pointed out or distinctly claimed. A claim that includes a chemical compound cannot be open-ended, but must be claimed with precision. This rejection can be overcome by amending the phrase “has the formula” to read “is of the formula” in claim 3.

IV. Objections

Claim Objections

Claim 1 is objected to because of the following informalities: the letter (b) has been duplicated.

V. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626